

### **REMARKS**

Claim 8 is pending in the above-identified application. The Drawings are objected to because of incorrect reference numbers in **FIGURE 9**. Claim 1 is rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Claim 8 is rejected under 35 U.S.C. §102(b) as being anticipated by Nextag.com. ([http://web.archive.org/web/20010122041400/www.nexttag.com/serv/main/buyer/Home.jsp;\\$sessionid\\$6Dy+vhsthAcvzX1ZcUo](http://web.archive.org/web/20010122041400/www.nexttag.com/serv/main/buyer/Home.jsp;$sessionid$6Dy+vhsthAcvzX1ZcUo); hereinafter referred to as "Nextag"). Claim 8 is rejected under 35 U.S.C. §102(e) as being anticipated by Thomas et al. U.S. Pat. No. 7,319,979; hereinafter referred to as "Thomas").

Applicants submit that these amendments and remarks overcome all of the Examiner's outstanding objections and rejections and bring the present Application into condition for allowance. Entry of this amendment and a notice of allowance of all the remaining claims are therefore respectfully solicited.

#### **Objections to the Drawings**

**FIGURE 9** is amended to correct incorrectly place reference numerals. Applicants therefore respectfully request withdrawal of the objection to the Drawings.

#### **Objections to the Specification**

Paragraphs [0049] is amended to correct a minor typographical error, identified in the current Office Action dated June 5, 2008. Applicants therefore respectfully request withdrawal of the objections to the Specification.

#### **Rejections Based on §101**

Claim 8 is amended to replace the word "for" with the word "of." Although Applicants do not agree the word "for" makes the claim indefinite, the amendment is being entered merely to facilitate prosecution. Therefore, Applicants respectfully request withdrawal of the §101 rejection of claim 8.

**Rejection Based on §102(b)**

Claim 8 is rejected under 35 U.S.C. §102(b) as being anticipated by Nextag. Simply stated, Nextag is directed to a single web service that sells tangible products, e.g. computers, electronics, software, etc. In contrast, Applicants' claimed subject matter is directed to a service that provides web services, for example, a service to determine a need for nursing care (¶[0112], lines 1-4). In other words, Nextag does not anticipate claim 8 because Nextag is not directed to a method for selecting among services, much less web services, which are a particular type of service understood by those with skill in the art. Rather, Nextag is a web service, which a user has already selected, that sells tangible products.

The O.A. mischaracterizes "products" as "services" (p. 4, lines 18-21), which generates obvious and widening differences with the claimed subject matter. For example, there is no suggestion in Nextag that anything other than product descriptions are provided to the user and certainly not a "number of times the software services have been used, a frequency of use corresponding to the software services; an execution time corresponding to the software services; and a maintenance time corresponding to the software services." In fact, these particular metrics are not even applicable to product descriptions. In other words, Nextag does not anticipate Applicant's claimed subject matter because products cannot be described by, for example, "frequency of use," "execution time" and "maintenance time."

Therefore, for the reasons stated above, Applicants respectfully request withdrawal of the §102(b) rejection of claim 8.

**Rejection Based on §102(e)**

Claim 8 is rejected under 35 U.S.C. §102(e) as being anticipated by Thomas. Rather, than returning a list of software services and corresponding quality information, Thomas transmits to a broker a request for a service that satisfies certain requirements, specifically proxy and protocol standards. In other words, Thomas is directed to a service that "relieve[s] [a client] from having to develop a communications code" (Abstract, lines 12-13). In other words, Thomas is directed to locating a service meeting specific communication requirements rather than providing information about "quality of services." Like Nextag, Thomas simply does not include any suggestion or teaching of information associated with a software service relating to

"frequency of use," "execution time" and "maintenance time." Therefore, Applicants respectfully requests withdrawal of the §102(e) rejection of claim 8.

To anticipate a claimed invention under §102(b) or (e), all the claim limitations must be taught or suggested by the prior art. (M.P.E.P., §2143.03, citing *in re Royka*, 490 F.2d 981; 180 U.S.P.Q. 580 (CCPA 1974)). In addition, "All words in a claim must be considered in judging the patentability of that claim against prior art." (*Id.*, citing *In re Wilson*, 424 F.2d 1382, 1385; 165 U.S.P.Q. 494, 496 (CCPA 1970); *emphasis added*). Applicants believe that the cited art fails to meet this standard. For the reasons above, claim 8 is allowable over the cited art. Therefore, Applicants respectfully request withdrawal of the §102(b) and (e) rejections of claim 8.

### CONCLUSION

In light of the amendments and remarks made herein, Applicants submit that the pending claim is allowable and earnestly solicits notice thereof. Applicants are not conceding in this application that the unamended claims are not patentable over the art cited by the Examiner, as the present claim amendment is only for facilitating expeditious prosecution of the allowable subject matter. Applicants respectfully reserve the right to pursue these and other claims in one or more continuation and/or divisional patent applications. A Request for a One-Month Extension of Time to file this Amendment by October 6, 2008 is being filed and paid for concurrently with this filing. It is believed that no other fees are due with the filing of this Amendment/Response. However, should any other fees be due, the Commissioner is hereby authorized to charge such fees to the deposit account of IBM Corporation, Deposit Account No. 09-0447.

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Respectfully submitted,

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**APPENDIX A**

**Amendments to the Drawings:**

Please replace **FIGURE 9** with the following amended **FIGURE 9**. Both a clean copy and an amended copy showing the changes made are included